

### **REMARKS/ARGUMENTS**

The Office Action dated November 16, 2004 has been carefully reviewed, and these remarks are responsive thereto. Applicants respectfully request reconsideration and allowance of this application.

Claims 1-11, 17-28, and 30-48 remain pending in this application. By this Amendment, claims 1, 2, 6, 7, 17, 18, 22, 23, 28, 30, 34, 38-41, 43-46, and 48 are amended to more clearly indicate that various input parameters are selected and/or introduced by a user via a computer. Clarifying amendments are made to claims 31, 32, 35, and 36. Support for these claim amendments is readily apparent from the original specification and claims. See, for example, original Figs. 5 and 6 and the corresponding description thereof. No new matter is included in this Amendment, and no additional claim fees are due as a result of this Amendment.

#### **I. THE CLAIMS PATENTABLY DISTINGUISH FROM RAY**

The Office rejected claims 1, 2, 5, 7, 10, 11, 17, 18, 21, 23, 26-28, and 30-48 under 35 U.S.C. § 102(e) as allegedly anticipated by Ray, et al., U.S. Patent No. 6,018,722 (hereinafter "Ray"). Additionally, claims 3, 4, 6, 8, 9, 19, 20, 22, 24, and 25 were rejected as allegedly obvious (35 U.S.C. § 103(a)) based on the Ray patent. Applicants respectfully traverse these rejections and request reconsideration.

Applicants' invention, as recited in claim 1, relates to computer-implemented methods for creating a portfolio of issues. Such methods may include: (a) receiving user input, via a computer, identifying specific issues to be added to the portfolio, (b) receiving user input, via a computer, indicating a selection of one of a plurality of options for creating the portfolio, and (c) receiving user input, via a computer, indicating a past date for purchase of the portfolio. Once this input data is received, the portfolio is created and the portfolio's past performance is calculated by the computer based on the option selected and the past date. Applicants' independent claim 17 recites a computer-readable medium having a computer-executable program stored thereon for creating a portfolio via a method as generally described above.

The method described in the Ray patent differs fundamentally from the methods recited in Applicants' claims 1 and 17 (and their associated dependent claims). For example,

Applicants' claimed methods include receiving user input, via a computer, identifying specific issues to be added to the portfolio. In contrast, the Ray method does not require users to identify specific issues to be added to a portfolio. Rather, in the Ray method, users input various personal information (such as information regarding age, risk tolerance, investment goals, and the like – see column 5, lines 1-18 (cited by the Examiner)), and the system uses various models to automatically select a portfolio for the user. In other words, in Ray's method, the system selects the portfolio for the user -- the user does not identify specific issues to be added to the portfolio. Accordingly, the Ray method does not teach or suggest receiving user input, via a computer, identifying specific issues to be added to a portfolio, as recited in Applicants' claims 1 and 17.

Moreover, Applicants' claims 1 and 17 recite receiving user input, via a computer, indicating a past date for purchase of the portfolio and then calculating the portfolio's past performance based on, *inter alia*, this past date. Again, this step is not taught or suggested in Ray. Notably, the Office points to no specific disclosure in Ray as providing this teaching. See the Office Action at pg. 2, the last line. While Ray indicates that his system keeps up with the market and the client accounts status on a daily basis to enable the data to be current (see Ray at column 4, lines 52-55), this disclosure in Ray falls far short of teaching or remotely suggesting Applicants' claimed method in which user input identifying specific issues to be added to a portfolio, as well as user input indicating a past date for purchase of the portfolio, are entered by the user via a computer. Additionally, Ray does not teach or suggest calculating a portfolio's past performance based on the past date indicated by the user.

For these reasons, Applicants respectfully submit that claims 1 and 17, as well as their corresponding dependent claims, patentably distinguish from Ray. Withdrawal of the rejections and allowance of these claims are earnestly solicited.

Applicants' independent claim 28 recites a system for creating a portfolio of issues. This claim recites that the system includes an input system that receives, *inter alia*, a designation of issues from a user to be included in the portfolio. As described above, the Ray system automatically determines a portfolio for a user based on a user's personalized information. The Ray system does not receive a designation of issues from a user as recited in Applicants' claim

28. Accordingly, Applicants respectfully submit that claim 28 patentably distinguishes from the system described in Ray.

Applicants' independent claims 34 and 30, respectively, recite a computer-implemented method and a computer-readable medium including a computer-executable program stored thereon for creating a portfolio of issues that: (a) receive identification of specific issues to be added to a portfolio from a user via a computer, and (b) receive identification of a past closing date for the issues from a user via a computer. Additionally, the method and program recited in these claims create the portfolio based on the specific issues identified by the user and historical prices obtained based on the past closing date identified by the user. Applicants respectfully submit that Ray does not teach or suggest a method and/or a computer-readable medium having the features recited in claims 34 and 30, respectively. Rather, the Ray system automatically determines a portfolio for a user based on a user's personalized information. Withdrawal of these rejections and allowance of these claims are earnestly solicited.

Applicants' independent claims 38 and 43 recite methods and computer-readable media, respectively, for creating a portfolio of issues in which user input is received identifying specific issues to be added to the portfolio. Applicants respectfully submit that the Ray patent does not teach or suggest programs and/or methods in which user input is received identifying specific issues to be added to a portfolio. Rather, as described above, in the Ray system, the issues included in the portfolio are automatically generated by the system upon evaluating various information, including personalized information input by the user. Accordingly, Applicants respectfully submit that claims 38 and 43, as well as their associated dependent claims, patentably distinguish from the program and method of Ray.

Applicants' independent claim 48 recites a system for creating a portfolio of issues in which an input system is provided that, *inter alia*, receives a designation of issues from a user to be included in the portfolio. As described above, the Ray system automatically determines a portfolio for a user based on a user's personalized information. The Ray system does not receive a designation of issues from a user as described in Applicants' claim 48. Accordingly, Applicants respectfully submit that claim 48 patentably distinguishes from the system described in Ray.

In view of the foregoing, Applicants respectfully submit that claims 1-11, 17-28, and 30-48 patentably distinguish from the systems, methods, and computer-readable media disclosed in Ray. Withdrawal of these rejections and allowance of these claims are earnestly solicited.

## II. CONCLUSION

If the Examiner believes that a telephone conference or a personal interview will be useful to advance the prosecution of this application and/or place the application in condition for allowance, he is invited to contact the undersigned attorney by telephone.

Applicants believe that no fee is required for this submission. However, if any fees are required, such as fees under 37 C.F.R. §§ 1.16 or 1.17, or if an extension of time is necessary that is not accounted for in the papers filed with this Amendment, the Commissioner is authorized to debit our Deposit Account No. 19-0733 for any necessary fees, including any necessary extension fees.

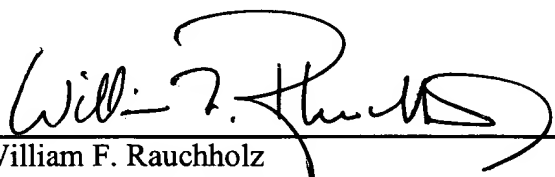
All rejections having been addressed, Applicants respectfully submit that this application is in condition for immediate allowance and respectfully solicit prompt notification of the same.

Respectfully submitted,

BANNER & WITCOFF, LTD.

Dated: January 13, 2005

By:

  
William F. Rauchholz  
Registration No. 34,701

1001 G Street, N.W.  
Washington, D.C. 20001-4597  
Tel: (202) 824-3000  
Fax: (202) 824-3001  
WFR/dah